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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,385	02/18/2004	Satoshi Mizutani	200500200895-US0	3573
7278	7590	07/28/2008		
DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER	
			BOGART, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3761	
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			07/28/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/782,385

**Applicant(s)**

MIZUTANI ET AL.

**Examiner**

MICHAEL G. BOGART

**Art Unit**

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 6, 9-12, 20, 23, 24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 9-12, 20, 23, 24, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 1 is objected to because of the following informalities: In the third line from the last line, before “junction”, the word “the” should be deleted. Appropriate correction is required.

### *Claim Rejections – 35 USC § 103*

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

2. Claims 1, 6, 9, 12, 20, 23, 24, 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizutani *et al.* (WO 02/094148 A1; hereinafter “Mizutani”). For the purposes of illustration, all references are made to the English language equivalent document US 2004/0158222 A1.

Regarding claim 1, Mizutani teaches an interlabial pad (20) comprising:

a first sheet (21) forming a surface side sheet configured contacting a body, the first sheet (21) having a permeable property for liquid;

a second sheet (22) independent from the first sheet (21) and forming a back face side sheet configured to be positioned away from the body, the second sheet (22) including a plurality of sheet pieces (24A, 24B), each partially overlapping another sheet piece;

an absorbent body (23) for absorbing liquid, the absorbent body (23) being disposed between the surface side sheet (21) and the back face side sheet (22);

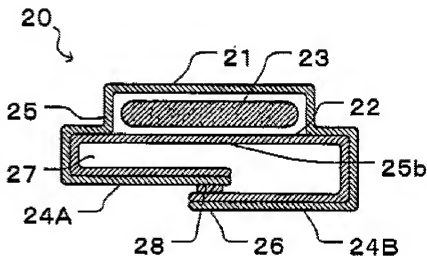
a junction joining the surface side sheet (21) and the back face side sheet (22) at a peripheral edge of the absorbent body (23), the absorbent body (23) being enclosed thereby between the surface side sheet (21) and the backface side sheet (22);

at least one seam part (26) of the second sheet (22) formed by overlapping the plurality of sheet pieces (24A, 24B) over one another, the seam part (26) including:

a longitudinal seam part (26) extending in a longitudinal direction over a length of the interlabial pad (20), crossing over the second sheet (22) from an edge to another edge of the second sheet (22) and an adhesive agent (28) applied between the sheet pieces (24A, 24B) at the longitudinal seam part (26) along a longitudinal central line along the longitudinal direction, wherein one of the plurality of the sheet pieces (24B), which overlaps another one of the sheet pieces (24A) at the longitudinal seam part (26) and which covers a side of the other sheet piece (24A) that is closest to the longitudinal central line of the interlabial pad (20), is positioned at the

absorbent body (23) side of the second sheet (22), and wherein the sheet pieces (24A, 24B) are each formed of either a water disintegrable material or a biodegradable material to enable separation of the second sheet (22) along the longitudinal seam part and along the junction joining the surface side sheet (21) and the back face side sheet (21) so that the second sheet may be dispersed into the plurality of sheet pieces and into the sheet pieces (24A, 24B) when discarded by flushing (§s 0074 & 0234).

FIG. 18



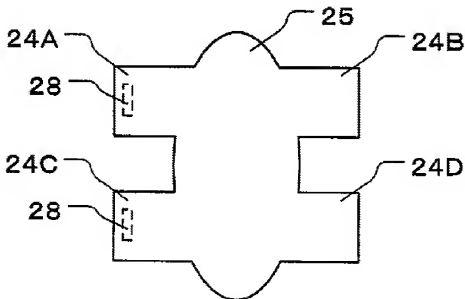
It is noted that the sheet pieces can degrade randomly at all portion of the sheet, including the portions at the longitudinal seam part and the junction of the first and second sheets.

Mizutani does not disclose the specific dimension of the overlapping portions or the relative length of the seam part. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative

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dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding claims 6 and 23, Mizutani teaches a lateral seam part (25) and a sheet piece (24A) overlapping a sheet piece (24B) at the seam part (see fig. 30, *infra*). Regarding the functional limitations of the claim, apparatus claims must be structurally distinguishable over the prior art. MPEP § 2114. The device of Mizutani can be folded in the claimed manner.

**FIG. 30**

Regarding claims 9 and 20, Mizutani teaches that the back face side sheet (22) is made uneven at least at the surface opposite the absorbent body (23) side (see fig. 18, *supra*).

Regarding claim 12, Mizutani teaches at least one parting zone (26) formed with the seam part (26) formed by the overlapping of the sheet pieces (24A, 24B).

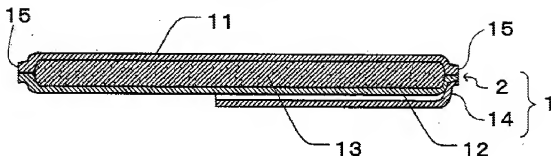
Regarding claim 24, Mizutani teaches that the back face side sheet (22) has two sheet pieces (24A, 24B).

Regarding claim 26, Mizutani does not teach the specific ranges of values for the basis weight of the adhesive. Generally, optimization of ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

One of ordinary skill in the art would have recognized that increasing the basis weight of adhesive would provide for increased adhesion while slowing dispersion in water.

Regarding claim 27, Mizutani teaches a mini sheet piece (14) attached at the junction (2) of sheets (11) and (12)(see fig. 1, *infra*).

FIG. 1



3. Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizutani as applied to claims 1, 6, 9, 12, 20, 23, 24, 26 and 27 above, and further in view of Osborn, III (WO 99/26573 A1; hereinafter "Osborn").

Mizutani does not disclose expressly the packaging sheet.

Osborn teaches a packaging body (50) for a sanitary pad (20), comprising:

a packaging sheet (68); and

a sanitary pad (20) covered by the packaging sheet (68);

wherein the packaging sheet (68) is provided with a continuous or discontinuous parting zone that is parted by actions of water, along which the packaging sheet (68) is separated into a plurality of small sheet piece when water after the packaging sheet is discarded in the toilet (page 19, line 20-page 21, line 23)(see fig. 5).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the packaging of Osborn to package the pad of Mizutani in order to provide packaging that is known in the art to be suitable for that purpose.



Regarding the functional limitations, e.g., how the back side sheet disperses after placement in a toilet, apparatus claims must be structurally distinguishable over the prior art. MPEP § 2114. Osborn discloses packaging that can optionally be constructed of a dissolvable material. Even if the packaging is not torn open, it will eventually dissolve, even if this not an intended use of the disclosure.

Regarding claim 11, Osborn teaches that the packaging sheet is a liquid impermeable sheet (e.g., thermoplastic film) with an impermeable property against liquid (page 19, lines 20-31).

#### ***Response to Arguments***

Applicant's arguments, see Remarks, filed 28 February 2008, with respect to the objections to the drawings have been fully considered and are persuasive. The objections to the claims have been withdrawn.

4. Applicants assert that the term "pieces" is generally understood to refer to a separate part of a whole item. This argument is not persuasive because the term can also be construed more broadly to mean a part of a whole, there is no general requirement that a piece must be physically separate. See *Merriam-Webster Online*, definition of "piece"; <http://www.merriam-webster.com/dictionary/piece>. Applicants note that if portions 24A and 24B are considered to be pieces of the backsheet 22, they are not pieces backsheet that enclose the absorbent body (23).
5. Applicants assert that the new limitation such that the seam part extends over an entire length of the pad. This argument is not persuasive because elements 24A and 24B are extensions of the backsheet (22). There is no requirement in the claims that all of the sheet pieces or

portions of the backsheet must enclose the absorbent body. The are extensions of the sheet and are made of the same materials and would disintegrate in a similar matter as the backsheet.

6. Applicants assert that the seam extending along an entire length of the pad . This argument is no persuasive for the reasons discussed in the detailed rejection of claim 1, *supra*. See *Gardner v. TEC Systems, Inc.*, *supra*.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. BOGART whose telephone number is (571)272-4933. The examiner can normally be reached on M-F, 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Bogart/  
Examiner, Art Unit 3761

/Tatyana Zalukaeva/

Supervisory Patent Examiner, Art Unit 3761